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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,770

07/06/2004

Peter Reginald Lewis

P14649-US

7038

27045 7590
ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR 1-C-11
PLANO, TX 75024

12/04/2008

EXAMINER

THOMPSON, MICHAEL M

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

12/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,770	Applicant(s) LEWIS, PETER REGINALD	
	Examiner Michael M. Thompson	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-6-04; 12-29-06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In the claims the term “means for providing services in exchange for units” appear to lack support in the specification. With respect to the “means for providing services in exchange for units” in claim 42, 37 CFR 1.75(d)(1) provides, in part, that “the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” In the situation in which the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function, and the examiner concludes that one skilled in the art would recognize what structure, materials, or acts perform the function recited in a means- (or step-) plus-function, the examiner should either: (A) have the applicant clarify the record by amending the written description such that it expressly recites what structure, materials, or acts perform the function recited in the claim element; or (B) state on the record what structure, materials, or acts perform the function recited in the means- (or step-) plus-function limitation. Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the USPTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP § 608.01(o) to explicitly state, with reference to

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the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim element. The examiner would like clarification as to which structure, materials, or acts perform the functions as recited in the claims. No new matter should be added.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 42-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** When the examiner considers the “means for providing services in exchange for units” under sixth paragraph, the scope of the claims is unclear so as not to insure that the public is informed of the boundaries of what constitutes infringement of the patent. Furthermore, it is unclear as to what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention. MPEP 2173.

4. **Claims 23-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** Generally, the term “units” are used within the claimed limitations without reference to which unit applicant is referring. A few examples are included to illustrate.

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5. **With respect to claim 24**, it is unclear if the term "units" refers to the consumed units in claim 23 or another distinct amount of units.
6. **With respect to claims 26, 27 and 28**, it is unclear if the term "units" refers to the "units" of claim 23 or claim 24 respectively.
7. **With respect to claims 31 and 32**, it is unclear as to which "units" Applicant is referring to when considering earlier dependencies.
8. **With respect to claims 33-35 and 37**, it is unclear as to which "units" Applicant is referring to when considering earlier dependencies.
9. **With respect to claim 42**, it is unclear as to the term "units" is either predetermined units or available units.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. **Claims 23-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed. For purposes of 101, the analysis of a process is guided by the machine-or-transformation test. *In re Bilski*, ___ F.3d ___ (Fed. Cir. 2008)(en banc).

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Based on Supreme Court precedent (*Diamond v Diehr*, 450 U.S. 175,184 (1981); *Parker v. Flook*, 437 US 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent precedent from the Federal Circuit from *In re Bilski*, the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson*, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101.

12. **Claims 23-41** are drawn to **a method for managing unit reservation of an account by a credit management system**. All of the recited method steps can be performed by the user themselves, in the mind of the user or between different users through writing by a user, and therefor these method steps are not tied to a particular machine nor do they transform an article. To qualify as a statutory process, the claim should positively recite in the body of the claim, the particular machine to which it is tied. For example, by identifying the particular machine that accomplishes the method steps, or positively reciting the article that is being transformed.

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Please note that ***nominal recitations of a machine in an otherwise ineligible method fail to make the method a statutory process***. See Benson, 409 U.S. at 70 - 72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, storing, collecting, sending, receiving, and other forms of insignificant extra solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of involvement of a machine or transformation in a method claim do not convert an otherwise ineligible claim into an eligible one. *Ex parte Langemyr* (2008) and *In re Bilski*, (Fed. Cir. 2008).

Therefore, the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein, and Applicants' claim here appears to fail this test. *In re Bilski*. No new matter should be added.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. **Claims 23-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (WO 98/56160).**

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15. **With respect to claim 23**, Smith et al teaches a method for managing unit reservation of an account by a credit management system in a multi service telecommunications system, wherein services are provided in exchange for units, wherein a predetermined amount of units (i.e. prepaid amount) is available for the account and which units are reserved before provisioning of a service (i.e. amount withdrawn to cover the cost for a call of typical duration), comprising: a step of forced booking during service provisioning by said credit management system of actually consumed units for at least one service (i.e. either the amount that is "force" booked such as the "short call" or it could be interpreted to be the amount that is "force" booked in subsequent allocations). (i.e. abstract, pg 5 lines 11-27, and pg 6-7 lines 12-4.)
16. **With respect to claim 24**, Smith et al teaches the method according to claim 23, wherein said forced booking is carried out if said amount of units drops below a predetermined threshold. (i.e. the amount that is "force" booked such as in the case of a "short call" or similarly if there is a threshold determination similar to page 9, lines 15-27.) (i.e. abstract, pg 5 lines 11-27, and pg 6-7 lines 12-4)
17. **With respect to claim 25**, Smith et al teaches the method according to claim 24, wherein said forced booking is service dependent. (i.e. in this case the booking is service dependent on prepaid accounts associated with the cost of a call. On page 7 lines 2-4 other types of services are indicated.) (i.e. abstract, pg 5 lines 11-27, and pg 6-7 lines 12-4)
18. **With respect to claim 26**, Smith et al teaches the method according to claim 25, wherein in connection with said forced booking a request for accreditation of units can

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be carried out for said services. (i.e. remaining time is inherently accounted for, abstract, pg 5 lines 11-27, and pg 6-7 lines 12-4) (i.e. interpreted otherwise, the time is "accredited" by different methods as described on pages 8-9 lines 27-9 and as well on pages 10-13.)

19. **With respect to claim 27**, Smith et al teaches the method according to claim 26, wherein accreditation of said units is subject to a plurality of accreditation rules. (i.e. the time is "accredited" by different methods as described on pages 8-9 lines 27-9 and as well on pages 10-13 in the form of rules for accreditation.)

20. **With respect to claim 28**, Smith et al teaches the method according to claim 27, in which at least one of said accreditation rules is dependent on the actual use of said units per unit of time per service. (i.e. all calculations are related to actual use and are based on time when using the prepaid calling service since determining the calling time that remains is critical. These methods are exemplified by the different methods as described on pages 8-9 lines 27-9 and as well on pages 10-13.

21. **With respect to claim 29**, Smith et al teaches the method according to claim 27, in which at least one of said accreditation rules is dependent on a classification of said services. (i.e. such as the accreditation rules of 27, they are related to the phone billing services, pages 8-9 lines 27-9 and as well on pages 10-13.)

22. **With respect to claim 30**, Smith et al teaches the method according to claim 29, wherein said classification is a prioritization. (i.e. in this case the priority is related to prepaid calling services. On page 7 lines 2-4 other types of services are indicated.)

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23. **With respect to claim 31**, Smith et al teaches the method according to claim 27, in which at least one of said accreditation rules is dependent on the amount of units requested. (i.e. accreditation rules inherently rely on the amount of units requested to determine the amount of units remaining as described on, for example, pages 8-9 lines 27-9 and as well on pages 10-13 in the form of rules for accreditation.)

24. **With respect to claim 32**, Smith et al teaches the method according to claim 27, in which at least one of said accreditation rules is dependent on the life-span of requested units. (i.e. rules such as the initial "typical duration" of 4 minutes withdrawn amount on page 5 lines 11-27 relating to a "life-span" of requested units.)

25. **With respect to claim 33**, Smith et al teaches the method according to claim 32, wherein said units are monetary units. (i.e. inherently the units are related to both time and money where units of time us used as a quantity at a given rate translating to monetary value. The terms are synonymous especially in the context of prepaid calling services where calling times are typically related in total minutes at a given value thereby conferring a monetary unit.)

26. **With respect to claim 34**, Smith et al teaches the method according to claim 32, wherein said units are units of time. (i.e. Similarly, the units are inherently related to both time and money where units of time us used as a quantity at a given rate translating to monetary value. The terms are synonymous especially in the context of prepaid calling services where calling times are typically related in total minutes at a given value thereby conferring a monetary unit.)

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27. **With respect to claim 35**, Smith et al teaches the method according to claim 32, wherein said units are units of volume. (i.e. the units are inherently a unit of volume, since the total time allocated at a given prepaid price will constitute a volume of time. Similarly not the rationale in the rejection of claims 26 and 27.)

28. **With respect to claim 36**, Smith et al teaches the method according to claim 35, wherein said volume is a data volume. (i.e. may be interpreted as call data or service data collected by the Service Data Function, on page 6-7, lines 12-23, and/or any type of call as described on page 8, lines 7-11.)

29. **With respect to claim 37**, Smith et al teaches the method according to claim 32, wherein said units relate to the amount of used bandwidth. (i.e. the use of certain different types of call including voice and/or videoconferencing telephone calls, facsimile calls, and calls to transfer data as described on page 8 lines 7-11, create bandwidth related to the exchange of information over communication lines. Such as often the case in dial up services. Also note that page 7, lines 24-31 refer to other interfaces and networks such as a radio air interface as well as other mobile models.)

30. **With respect to claim 38**, Smith et al teaches the method according to claim 37, wherein said account can be accessed by at least one user. (i.e. the use of the term "subscriber's account" designates the use of an accessible account providing for a method of determining, in the least, the time remaining on the account. Similarly, the claim may be interpreted to mean that at least one user can access the prepaid account, such as when they make a call on the account they have accessed the account for prepaid services.)

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31. **With respect to claim 39**, Smith et al teaches the method according to claim 38, which is used in a telecommunications environment, wherein at least one of the services provided relates to a group comprising voice, data and internet communications. (i.e. the use of certain different types of call including voice and/or videoconferencing telephone calls, facsimile calls, and calls to transfer data as described on page 8 lines 7-11, create bandwidth related to the exchange of information over communication lines.)

32. **With respect to claim 40**, Smith et al teaches the method as described in claim 39, wherein said telecommunications environment is accessible via a group comprising wireless and fixed connections to a telecommunications network. (i.e. Please note that page 7, lines 24-31 and page 8, lines 1-6 refer to other interfaces and networks such as a radio air interface as well as other mobile models. Also note that pages 12-13, lines 20-5 refer to fixed networks.)

33. **With respect to claim 41**, Smith et al teaches the method according to claim 40, wherein management or provisioning of said services is carried out by a plurality of service provisioning systems which are in communicative connection with said credit management. (i.e. service provisioning systems such as the Service Data Function, Service Control Function, Intelligent Network, Service Control Points, Service Switching Function or Mobile Station Integrated Services Digital Network Number are some examples. These are found throughout and related to the credit management or determination of allocations.)

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34. **With respect to claim 42**, Smith et al teaches a multi service telecommunications system, comprising: at least one credit management system for registering or managing reservation of available units in an account comprising a predetermined amount of units, further comprising means for providing services in exchange for units, said means being further arranged for reserving units before provisioning of a service, wherein said credit management system is arranged for carrying out a forced booking of actually consumed units during service provisioning for at least one service. (This claim is rejected under a similar rationale as in claim 23, i.e. either the amount that is "force" booked such as the "short call" or it could be interpreted to be the amount that is "force" booked in subsequent allocations.) (As similarly described in the abstract, pg 5 lines 11-27, and pg 6-7 lines 12-4.)

35. **With respect to claim 43**, Smith et al teaches the multi service telecommunications system according to claim 42, wherein said credit management system forms at least a part of a device comprised in said telecommunication system. (i.e. the heart of the invention relates to a prepaid telecommunication system for prepaid calling that includes and is not limited to voice and/or video conferencing telephone calls, facsimile calls and calls to transfer data, etc., throughout and on page 8, lines 7-11.)

36. **With respect to claim 44**, Smith et al teaches the multi service telecommunications system according to claim 42, wherein said credit management system forms at least a part of a user device comprised in an arrangement for connecting to said telecommunications system. (i.e. service provisioning systems such

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as the Service Data Function, Service Control Function, Intelligent Network, Service Control Points, Service Switching Function or Mobile Station Integrated Services Digital Network Number are some examples. These credit management systems are devices that connect to the telecommunications system.)

Conclusion

The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571) 270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629